



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

10/22/03
2/11/3
1761

In re Appln. Of: WILSON et al.

RECEIVED

JAN 28 2003

Serial No.: 09/896,375

TC 1700

Filed: June 29, 2001

For: IMPROVED FLAVORING COMPOSITION AND PROCESS...

Group: 1761

Examiner: Curtis E. Scherrer

DOCKET: STEINER 00.01

Assistant Commissioner of Patents
Washington, D.C. 20231

AMENDMENT A

Dear Sir:

This amendment is being filed in response to the Official Action mailed December 19, 2002. Provisional election is hereby made, with traverse, to prosecute the invention of Group II, comprising claims 12-25.

The restriction requirement is respectfully traversed. The Official Action has not established a prima facie justification for the requirement for election. The Official Action states:

“Inventions I and III are related as process of making and product made. ...In the instant case, the product as claimed can be made by another and materially different process, i.e., for the production of toothpaste.”

The Examiner’s suggestion in this regard is not understood. Inventions I and III specifically are directed to malt beverages. It is not seen how a process for production of toothpaste as suggested by the Examiner would produce the claimed malt beverage product. Needless to say, the Examiner cannot make out a case for restriction by ignoring claim limitations!

HAYES SOLOWAY P.C.
130 W. CUSHING ST.
TUCSON, AZ 85701
TEL. 520.882.7623
FAX. 520.882.7643

175 CANAL STREET
MANCHESTER, NH 03101
TEL. 603.668.1400
FAX. 603.668.8567

The Action also states:

"Inventions II and I are related as product and process of use. ... In the instant case the product as claimed can be made by another and materially different process, i.e., for the production of toothpaste."

Again, the Examiner's suggestion in this regard is not understood. Inventions I and II are also specifically directed to malt beverages. It is not seen how a process for the production of toothpaste, as suggested by the Examiner, would produce the claimed malt beverage product. Needless to say, the Examiner cannot make out a case for restriction by ignoring claim limitations!

The Examiner gives no specific reasons for restricting between claim Groups II and III. In this regard Applicants note claim Group III (claims 26 and 27) are specifically linked to claim Group II (claim 23). Thus, claim Groups II and III should be examined together.

In requiring restriction, the Examiner also notes the inventions are classified in different classes and sub-classes, thus alluding to the fact that the inventions would involve divergent fields of search. However, as the Examiner is well aware, such a factor per se is not a basis for determining distinctiveness in accordance with MPEP 806.

Furthermore, it is respectfully submitted that there is nothing in 35 USC § 121 that gives the Patent Office the authority to require restriction between different statutory classes of claims unless the claims cover "independent and distinct inventions." It is respectfully submitted that the statutory requirements not having been met here vis-à-vis Groups I and II respectively, the Examiner should withdraw the requirement for restriction and provide Applicants with an action on the merits of the withdrawn claims.

HAYES SOLOWAY P.C.
130 W. CUSHING ST.
TUCSON, AZ 85701
TEL. 520.882.7623
FAX. 520.882.7643

175 CANAL STREET
MANCHESTER, NH 03101
TEL. 603.668.1400
FAX. 603.668.8567

It should be noted that restriction requirements as prescribed by 35 USC § 121 are discretionary with the Examiner, and in view of the remarks above, the restriction requirement should be withdrawn.

In summary therefore, all of the claims are believed to be directed to a single invention. However, so as to be fully responsive, Applicants provisionally elect to prosecute Group II, i.e., claims 12-25, and it is requested that, without further action thereon, the remaining claims be retained in this Application pending disposition of the Application, and for possible filing of a divisional application.

An action on the merits is respectfully requested.

In the event there are any fee deficiencies or additional fees are payable, please charge them (or credit any overpayment) to our deposit account number 08-1391.

Respectfully submitted,



Norman P. Soloway
Attorney for Applicants
Registration No. 24,315

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Assistant Commissioner of Patents and Trademarks, Washington, D.C. 20231 on January 6, 2003, at Tucson, Arizona.

By Diana Carr

HAYES SOLOWAY P.C.
130 W. CUSHING ST.
TUCSON, AZ 85701
TEL. 520.882.7623
FAX. 520.882.7643

175 CANAL STREET
MANCHESTER, NH 03101
TEL. 603.668.1400
FAX. 603.668.8567